

REMARKS

Reconsideration is requested.

The claims of the present application are submitted to be in condition for allowance for the reasons noted in the Remarks of the Amendment Under Rule 116 filed May 8, 2009.

The undersigned has now appreciated from a review of the related application no. 12/165,686, that the publication and claims of the related application no. 12/165,686 (U.S. Patent Application Publication No. 20080269237) have not been cited to the Examiner in the above. A PTO 1449 Form listing same is attached hereto and a copy of the pending claims of the related application is attached hereto. The Examiner is requested to acknowledge consideration of the same by return of an initialed copy of the attached PTO 1449 Form.

The applicants note that the related application no. 12/165,686 is a continuation of the present application. The present application is the earlier-filed of the two applications. The Examiner of the present application is the Examiner of the related application.

The claims of the present application define compounds. Claims defining methods of inhibiting and treatment methods were canceled from the present application in an Amendment filed June 25, 2008. The method claims of the present application were rejected under Section 112, first paragraph, as allegedly not being supported by an enabling disclosure. See Office Action dated May 5, 2008.

The claims of the related application are not believed to raise an issue of Section 101 same invention double patenting as the claims of the present application define compounds while the claims of the related application define methods.

To the extent the claims of the related application may raise an issue of provisional double patenting, the applicants believe that MPEP § 804 would make a provisional obviousness-type double patenting rejection in the present application improper.

Specifically, MPEP § 804 states the following, in relevant part:

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

As the claims of the present application are believed to be in condition for allowance, any provisional obviousness-type double patenting rejection of any of the present claims (i.e., in the earlier-filed application) over claims of the related, later-filed application would be the only remaining rejection in the present application, which should be withdrawn according to MPEP § 804. A Terminal Disclaimer should not be required.

Return of an initialed copy of the attached PTO 1449 Form is also requested.

WATKINS et al
Appl. No. 10/509,732
Atty. Ref.: 620-334
Response Under Rule 116
May 11, 2009

The application is submitted to be in condition for allowance and a Notice to that effect is requested. The Examiner is requested to contact the undersigned, preferably by telephone, in the event anything further is required in this regard.

Respectfully submitted,

NIXON & VANDERHYE P.C.

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